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09/195,105	11/18/1998	PAUL A. FRANCISCO	2434.114	3966

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[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

2163

DATE MAILED: 12/05/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. <b>09/195,105</b>	Applicant(s) <b>Francisco, et al.</b>
	Examiner <b>Akiba Robinson-Boyce</b>	Art Unit <b>2163</b>
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
<b>Period for Reply</b>		
<p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>		
<b>Status</b>		
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>May 2, 2001</u>		
2a) <input type="checkbox"/> This action is FINAL.      2b) <input checked="" type="checkbox"/> This action is non-final.		
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.		
<b>Disposition of Claims</b>		
4) <input checked="" type="checkbox"/> Claim(s) <u>1-13</u> is/are pending in the application.		
4a) Of the above, claim(s) _____ is/are withdrawn from consideration.		
5) <input type="checkbox"/> Claim(s) _____ is/are allowed.		
6) <input checked="" type="checkbox"/> Claim(s) <u>1-13</u> is/are rejected.		
7) <input type="checkbox"/> Claim(s) _____ is/are objected to.		
8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.		
<b>Application Papers</b>		
9) <input type="checkbox"/> The specification is objected to by the Examiner.		
10) <input type="checkbox"/> The drawing(s) filed on _____ is/are objected to by the Examiner.		
11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved.		
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.		
<b>Priority under 35 U.S.C. § 119</b>		
13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).		
a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).		
*See the attached detailed Office action for a list of the certified copies not received.		
14) <input checked="" type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).		
<b>Attachment(s)</b>		
15) <input type="checkbox"/> Notice of References Cited (PTO-892)		
16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)		
17) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). <u>12</u>		
18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____		
19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)		
20) <input type="checkbox"/> Other: _____		

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## **DETAILED ACTION**

### ***Terminal Disclaimer***

1. The terminal disclaimer filed on 5/2/01 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of the full statutory term as presently shortened by any terminal disclaimer of commonly assigned Patent No. 5,875,433 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Cretzler (US Patent 5,644,724).

As per claim 1, Cretzler discloses:

at least one tax register located at a merchant or retailer location, said at least one tax register for processing consumer sales transaction data at the retailer location and ... (Col. 4, lines 16-19)...

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computing use tax data to be indicated to an appropriate state agency based upon at least one of the location of a consumer or where the purchased goods are to be shipped, said at least one tax register...(Col. 4, lines 25-28, col. 9, lines 12-140)

forwarding said transaction data and use tax data to one of the state agency and a credit card processing company for processing...(Col. 9, lines 35-40);

a first computer and...receiving and storing the forwarded use tax data from one of the credit card processing company and a merchant at the retailer location; and...(col. 10, lines 28-29);

a first communication link connecting at least one of (I) the tax register at the retailer location and (ii) the credit card processing company, to the first computer and memory at the state agency, said first communication link for permitting the tax register or credit card company to forward the use tax data to said first computer and memory whereby the tax data from the retailer is automatically forwarded to the state agency and stored in the first memory in order to help enforce tax laws and prevent consumers or merchants from avoiding the payment of use tax...(Col. 3, lines 32-41, Col. 10, lines 30-33).

The following is inherent with Cretzler's system because the tax information is already stored (See Col. 10, lines 16-18), therefore the computer must have a memory if it is supposed to receive information that is already stored:

corresponding first memory...

As per claim 2, Cretzler discloses:

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wherein the consumer purchased goods with one of a credit card...(Abstract, lines 8-12).

As per claim 8, Cretzler discloses:

wherein said link includes one of a telephone line...(Fig. 1, (16)).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3 , 4, 5, 7, 9, 10, 11, 12, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cretzler (US Patent 5,644,724). Cretzler teaches a point-of-sale tax collection system and method where taxes are remitted and collected in real time at point-of-sale locations.

As per claims 3, 11, Cretzler fails to disclose:

wherein the first communication link is one of a digital packet...

Official notice is taken that it is old and well known in the electronic communications art to utilize a digital packet switched network or a satellite network for a communications network. It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a digital packet switched network or a satellite network for a communications network because these type of networks are the most common and up-to-date resources for facilitating electronic

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communications. They allow fast, effective communication across wide area networks and vast geographical locations.

As per claims 4, 13, Cretzler discloses:

wherein the system includes means at the retailer location for accessing a credit card company in response to the transaction...(Col. 4, lines 37-41, and Col. 5, line 61-Col. 6, line 5); The following is inherent with Cretzler because since the consumer is utilizing his or her credit card to carry out the transaction, he or she would therefore like the charges to occur on that transaction medium. In addition, Cretzler teaches that the service bank of the customer (analogous to the credit card company) sends an approval authorization for credit and debit transactions. In conventional systems, this approval implies charging the consumer's credit card for the transaction:

the credit card company automatically charges the consumer's credit card.../means for charging a credit card...

As per claim 5, Cretzler discloses:

further including means for allowing the credit card company to forward use tax charge to the consumer to the state agency...(Col. 4, lines 37-53, with col. 10, lines 35-41, Col. 5, line 61-Col. 6, line 5).

As per claims 7, 9, Cretzler discloses:

the...network for allowing/enabling a consumer to purchase goods over the...network for a retailer...(Col. 4, lines 16-24);

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at least a first computer or register located at a merchant or retailer location, said first computer or register for processing consumer sales transaction data at the retailer location and forwarding use tax data to one of a state authorized entity and a credit card processing company;...(Col. 4, lines 16-28, col. 9, lines 35-40);

at least a second computer and corresponding memory disposed at the state authorized entity, the second computer and memory for receiving and storing forwarded used tax data from one of the credit card processing company and a merchant at the retailer location; and...(Col. 10, lines 28-29);

a first communication link connecting at least one of (I) the tax register at the retailer location and (ii) the credit card processing company, to the first computer and memory at the state agency, said first communication link for permitting the tax register or credit card company to forward the use tax data to said first computer and memory whereby the tax data from the retailer is automatically forwarded to the state agency and stored in the first memory in order to help enforce tax laws and prevent consumers or merchants from avoiding the payment of use tax...(Col. 3, lines 32-41, Col. 10, lines 30-33).

Cretzler's fails to disclose the following:

a digital data network...

Official notice is taken that it is old and well known in the electronic communications art to utilize a digital data network for a communications network. It would have been obvious to one of ordinary skill in the art to utilize a digital data network for a

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communications network because these type of networks are the most common and up-to-date resources for facilitating any type of electronic communications including sales transactions since they allow fast, effective communication across wide area networks and vast geographical locations. In addition, Cretzler discloses a telephone network which is analogous to a digital data network since telephone lines are no more than electronic data links for digital transmission.

The following is inherent with Cretzler because in Cretzler, the tax information is already stored (See Col. 10, lines 16-18), therefore the computer must have a memory if it is supposed to receive information that is already stored. In addition, it is essential that a computer have a memory in order to maintain data for various communication applications:

corresponding memory...

As per claim 10, Cretzler discloses:

wherein the first computer or register comprises tax data...(Col. 4, lines 16-28, col. 9, lines 35-40).

As per claim 12, Cretzler fails to teach the following:

wherein the state authorized entity is a State Treasury...

Official notice is taken that it is old and well known in the tax collection art for the state authorized entity to be the State Treasury. It would have been obvious to one of ordinary skill in the art for the state authorized entity to be the State Treasury because the State Treasury is one of the most popular and well known entities which collects taxes from both people and businesses.

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The state treasury is an essential part of the economic makeup of the country and in order to continue functionality is required to collect taxes.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cretzler (US Patent 5,644,724) in further view of Golden, et al (US Patent 5,774,872).

As per claim 6, Cretzler fails to teach the following, however Golden, et al discloses:  
further including means for issuing a tax stamp receipt to a consumer...(Abstract, lines 17-19).

It would have been obvious to one of ordinary skill in the art to include means for issuing a tax stamp receipt to a consumer in order to provide some type of evidence that the consumer actually paid what her or she owes.

### *Conclusion*

7. An inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba Robinson-Boyce whose telephone number is (703) 305-1340. The examiner can normally be reached on Monday-Friday from 6:30AM-3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3988.

An inquiry of a general nature or relating to the status of this application proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

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**Akiba Robinson-Boyce**

**Patent Examiner**

**Group Art Unit 2163**

**November 27, 2001**

  
TARIQ R. HAFIZ  
SUPERVISORY PATENT EXAMINER  
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